REMARKS

The Office Action of September 4, 1998, has been carefully considered.

It is noted that a new title is required.

The disclosure is objected to for containing various informalities.

Claims 1-22 are rejected under 35 USC 112, second paragraph.

Claims 1-22 are rejected under 35 USC 112, first paragraph.

Claims 1-4, 7-14, 19, 20 and 22 are rejected under 35 USC 103(a) over European reference 099,264 to Doyle in view of applicants' admitted prior art and the patent to Raschke, et al.

Claims 5, 6 and 15 are rejected under 35 USC 103(a) over Doyle in view of applicants' admitted prior art and Raschke, et al., and further in view of the patent to Back.

Claims 16 and 17 are rejected under 35 USC 103(a) over Doyle in view of applicants' admitted prior art and Raschke, et al., and further in view of the patent to Chu, et al.

Claim 18 is rejected under 35 USC 103(a) over Doyle in view of applicants' admitted prior art and Raschke, et al. and further in view of the patent to Peterson.

Claim 21 is rejected under 35 USC 103(a) over Doyle in view of applicants;' admitted prior art and Raschke, et al. and further in view of the patent to Tomanek.

In connection with the Examiner's requirement for a new title, applicants have cancelled the original title and presented a new title which is believed to be more descriptive of the invention to which the claims are directed.

In view of the Examiner's objection to the disclosure applicants have amended the specification to address the points raised by the Examiner. In view of these changes it is respectfully submitted that the objection to the disclosure is overcome and should be withdrawn.

In view of the Examiner's rejections of the claims applicants have cancelled claim 11, added new dependent claim 29, and amended claims 1, 2 and 13.

It is respectfully submitted that the claims now on file particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants have amended claim 13 to delete the phrase "energy-rich". Furthermore, claim 1 has been amended to clarify what "their" in line 4 referred to.

In view of these considerations it is respectfully submitted that the rejection of claims 1-22 under 35 USC 112, second paragraph, is overcome and should be withdrawn.

It is also respectfully submitted that the subject matter contained in the claims is described in the specification so as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Relative to claim 2, this claim originally contained alternative recitation. The alternative configurations have been deleted from claim 2 and new claim 29 has been added which recites the alternative steps. With respect to claim 11, this claim is cancelled. Relative to claim 1, applicants respectfully submit that those skilled in the art are aware of materials which can be broken down to change the ink acceptance behavior of the layer corresponding to the printed picture to be produced. Furthermore, applicants respectfully submit that those skilled in the art are readily aware of how to use a laser to melt, ablate or break down a toner material. On a simple basis this can be carried out by changing the intensity or strength of the laser to accomplish the desired result.

In view of these considerations, it is respectfully submitted that the rejection of claims 1-22 under 35 USC 112, first paragraph, is overcome and should be withdrawn.

It should be mentioned that the claims now on file specifically define a method of imaging and erasing an erasable printing form by electrically charging the printing form over its

entire surface so that liquid toner particles are attracted by the printing form to form a layer, controlling the thickness of the layer of liquid toner particles for controlling either the voltage or time of the charging step, fixing the liquid toner particles with a source of energy in accordance with the picture to be printed, removing or breaking down non-fixed liquid toner particles to change acceptance behavior of the layer, and erase the printing form as a whole after a printing process takes place by removing the fixed liquid toner particles.

It is respectfully submitted that the claims now on file differ essentially and in an unobvious, highly advantageous manner from the methods disclosed in the references.

Turning now to the references, and particularly to the Doyle reference, it can be seen that Doyle teaches improvements relating to printing plates in which a plate is prepared by uniformly coating a substrate with a powdered material. As the Examiner correctly points out, Doyle does not teach or disclose charging the printing form, applying liquid toner particles and erasing the fixed toner particles after printing takes place. Although applicants on page 1, lines 6-13 discuss a reference which utilizes either charged dry or liquid toner particles, the liquid or dry toner particles of this reference are only applied to non-exposed places of the printing form, which toner particles are then fixed by heat. There is nothing in the teaching of applicants' admitted prior art or in the teachings of Doyle which would suggest to those skilled in the art that the dry toner particles of Doyle could be replaced with liquid toner particles and sprayed over the entire substrate surface. Doyle clearly only teaches a process wherein the entire surface could be covered by dry toner particles. The prior art referred to by applicants in the present application, on the other hand, only applies liquid toner particles to non-exposed portions of the printing form, not the entire surface of the printing form. These are entirely different process steps and a modification of Doyle in view of applicants' admitted prior art to cover the entire surface of the substrate with a liquid toner particles

would not be obvious from these references. Furthermore, the patent to Raschke, et al. discloses a two step process in which powder from a holder 24 is transferred to the belt 10 which is passed by working stations 32, 30 and then the transfer of the powder to the master takes place with the help of the roller 36. Raschke, et al. do not teach a method having the steps as recited in the presently claimed invention. Furthermore, since Doyle teaches a one step process and Raschke, et al. teach a two step process it would not be obvious to those skilled in the art to intermingle the teachings of these references. Furthermore, the process of Raschke, et al. utilizes a photoconductive screen 30, which is not utilized in the presently claimed invention.

Thus, it is respectfully submitted that the references cited by the Examiner respectfully teach specific processes which would not be obvious to alter in light of the teachings of the other respective references. Each of the references has unique process steps which when changed would substantially alter the process recited in the reference and thus would not be obvious to undertake by those skilled in the art. Furthermore, although the applicants' admitted prior art teaches a process which utilizes either dry or liquid toner particles, these particles are applied in a specific manner and there is nothing in the teachings of the references which would suggest altering this application of particles so that it should cover the entire substrate surface. The references provide no suggestion for making such a change.

In view of these considerations, it is respectfully submitted that the rejection of claims 1-4, 7-14, 19, 20 and 22 under 35 USC 103(a) over a combination of the above-discussed references is overcome and should be withdrawn. As for the various other references cited against the dependent claims in combination with the previously discussed references, these have also been considered. Since they do not come closer to the currently claimed subject matter than the

references discussed above it is believed that any detailed comments thereon at this time would be superfluous.

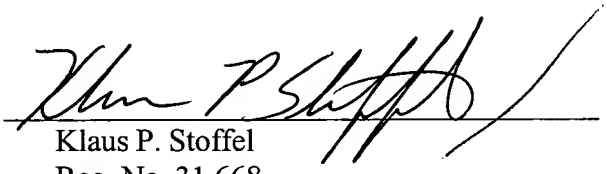
Therefore, it is respectfully submitted that the rejections of claims 5, 6, 15-18 and 21 under 35 USC 103(a) are overcome and should be withdrawn.

Reconsideration and allowance of the present application are respectfully requested.

It is believed that no fees or charges are required at this time in connection with the present application ; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 

Klaus P. Stoffel
Reg. No. 31,668
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: January 4, 1999